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REMARKS

Claims 1-7 and 10-12 stand rejected under 35 U.S.C. §103(a) as being obvious over Dutta (U.S. Patent Application Publication No. US 2003/0065571) (hereinafter "Dutta") in view of Eldreth (U.S. Patent No. 6,721,795) (hereinafter "Eldreth"). Claims 8-9 stand rejected under 35 U.S.C. §102(e) as anticipated by Eldreth. In light of the arguments below, the Applicant respectfully traverses the rejections and request reconsideration and allowance of the pending claims.

Rejections Under 35 U.S.C. §103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991).

Independent Claim 1

The Examiner rejects independent claim 1 as obvious over Dutta in view of Eldreth, relying on several points of rejection. Therefore, several points of rejection will be discussed in turn.

To support a rejection of claim 1 as obvious, the Office Action states:

As per claim 1, Dutta substantially teaches the invention as claimed wherein a method for obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server, comprising:

...
determining by the external server that the request for information is through the proxy server ([0028], [0031]); (Office Action, page 3).

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The Applicant respectfully asserts that claim 1 is unobvious over Dutta in view of Eldreth where the cited language fails to disclose *determining* by the external server that *the request is through the proxy*, as in claim 1 of the Application.

Claim 1 of the Application states in relevant part:

A method for obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server, comprising:

determining by the external server that the request for information is through the proxy server; (Emphasis added).

The language cited by the Examiner as disclosing the determining step of claim 1 states:

[0028] FIG. 2 shows the process flow of a preferred embodiment of the invention. The e-commerce server desires to negotiate and/or close an e-commerce sale, 201. The e-commerce server *examines the IP address of the client or the client's proxy*; and requests the "IP address to physical location/jurisdiction" database to look up and return the jurisdiction corresponding to the IP address of the client, 202. The e-commerce server then applies the laws of the corresponding jurisdiction to further negotiate and/or close the sale transaction, 203. This is further illustrated by blocks 211, 212, 213 showing different possible jurisdictions of different clients. Depending upon the physical location, the laws of the corresponding jurisdiction are applied. In a preferred embodiment, as disclosed in copending application Ser. No. _____ (Internal Docket Number AT9-99-573), an e-commerce web server, (e.g., 101, FIG. 1), after accessing the database, (e.g., 102, FIG. 1), for the jurisdiction, would then access a jurisdictional web server that has, or has access to, the laws of each jurisdiction. (Emphasis added).

[0031] There are situations where the client connects via a *proxy server* such as aol.com. In such cases, *the Web server may not directly know the IP address of the Web client but knows the IP address of the proxy server*. In the overwhelming majority of situations, Web clients connect to Web servers via proxy servers located within their own jurisdiction. It is rare for a person in United Kingdom to dial-up an America Online service provider in USA and connect to the Internet. Hence in the vast majority of situations, *using the jurisdiction of the proxy instead of the actual client would cause no difference to the result. Hence, for the*

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remainder of the application, reference to the network address or IP address of the client shall refer to the address of the client or the proxy of the client, i.e., a computer acting on behalf of a client. (Emphasis added).

The Applicant respectfully asserts that the language cited by the Examiner nowhere discloses *determining* that a request is coming *through a proxy*. While the above cited language indeed discloses a user request coming through a proxy server, it does not disclose *determining* that the user's request came through a proxy server. In fact, Dutta expressly states that *no distinction* is made between users who directly connect to a web server, and those who are connecting to a web server *through a proxy server*.

Dutta states in relevant part:

The e-commerce server *examines the IP address of the client or the client's proxy* (Dutta at [0028]) (Emphasis added).

reference to the network address or *IP address of the client shall refer to the address of the client or the proxy of the client*, (Dutta at [0031]) (Emphasis added).

E-commerce server looks at the *IP address of the client or the client's proxy* and requests the database to return the jurisdiction (Dutta at Figure 2, item 202) (Emphasis added).

Since Dutta makes no distinction between the IP addresses of users who directly connect to a server, and the IP address of the proxy through which a user may connect, Dutta logically does not disclose *determining* that a request is coming *through a proxy server*. Thus, the Applicant respectfully asserts that Dutta does not disclose the step of *determining* that a request is *through a proxy server* as in claim 1 of the Application.

As a second point of rejection with regard to claim 1 of the Application, the Examiner asserts that Dutta discloses:

redirecting by the *external server* the request for information to an *internal server* of the private network (Fig. 4, item 401; [0015-0016], wherein the request for physical address location is forwarded to a dedicated server for this service); the server determining *the geographic location of the Internet user* (wherein the determination is done through the database located remotely from the requesting sever); (Office Action, page 3) (Emphasis added).

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The Applicant respectfully asserts that claim 1 is unobvious over Dutta in view of Eldreth where the cited language fails to disclose the step of *redirecting by the external server* the request for information *to an internal server* of the private network, as in claim 1 of the Application.

Claim 1 of the Application states in relevant part:

redirecting by the external server the request for information to an internal server of the private network, the internal server determining the geographic location of the Internet user;
(Emphasis added).

The language cited by the Examiner as disclosing the *redirecting* step of claim 1 states:

[0015] The preferred embodiment, as disclosed herein, has an e-commerce server that is communicatively connected to a plurality of clients dispersed across multiple geographical jurisdictions. The e-commerce server is connected to a database of IP addresses that are mapped to physical locations. As such, the Internet address of each client computer is mapped to the physical location of the computer. A preferred embodiment utilizes the fact that IP addresses are allocated uniquely and are registered on a geographical basis according to allocation guidelines. Therefore, it is possible to locate, within a reasonable degree of accuracy, the jurisdiction of a buyer by the IP address of the client machine being used by the buyer in the e-commerce transaction.

[0016] As such, the system, method, and program of the invention determines dynamically, and automatically, a physical location of a client participating in the commercial transaction over the network with the server. Instead of querying the buyer for the buyer's physical location, the server dynamically determines the location by using the network address of the client from the client's connection request. The server then automatically retrieves the physical location corresponding to the network address from a database. The determined physical location is then used to apply applicable laws of a jurisdiction encompassing the physical location to the commercial transaction between the server and the client.

Dutta at Figure 4, item 401, discloses:

Get IP address of Client

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The Applicant respectfully asserts that the cited language and Figure from Dutta do not disclose *redirecting* by the *external server* the request for information to an *internal server* of the private network, as in claim 1 of the Application. As discussed above with regard to the determining step, Dutta discloses using the IP address of the proxy server instead of the actual IP address of the user residing on the private network and connected to the web server through the proxy server. The cited language from Dutta, while using the word *client*, is only referring to the IP address and location of the *proxy server* through which the client connects, not the actual IP address or location of the *user*. Thus, the system in Dutta does not concern or operate within the private network to which the user is connected, and so logically Dutta does not disclose an *internal server* of the private network.

The Applicant also respectfully asserts, by extension, that since Dutta does not disclose an *internal server* on a private network, Dutta likewise does not disclose *redirecting*, by an external server, a request to an *internal server* on a private network. Thus, the Applicant respectfully asserts that Dutta does not disclose an *internal server*, or *redirecting, by an external server*, a request for information to an *internal server*, as in claim 1 of the Application.

The Applicant also respectfully asserts that the cited language from Dutta nowhere discloses the *geographic location of an internet user* as in claim 1 of the Application. Dutta discloses determining the *legal jurisdiction* of a product delivery location by using the IP address of the client. Dutta at [0013]. Dutta discloses legal jurisdictions such as countries, states, and cities. Dutta at [0010]; Dutta at Figs. 1, 2, 3, and 4.

As discussed above, the system in Dutta expressly makes no distinction between a user directly connected to a web server, and one who is indirectly connected to a web server through a proxy server, because, according to Dutta, two users of the same proxy are likely in the same legal jurisdiction. Dutta at [0031].

In contrast, claim 1 of the Application is drawn to a method for determining the *actual geographic location* of an internet *user* who is connected to a web server through a proxy, rather than the location of the *proxy* as in Dutta. The fundamental problem of obtaining the location of a *user* using a proxy server is addressed by claim 1 of the Application, and is a problem which is expressly *not* resolved in Dutta. For example, in today's environment of large area codes and free long distance, two users in very different

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geographic locations could access the internet using a dial-up modem to connect to the same dial-in proxy server (such as systems used by America Online). In this scenario, the system of Dutta would inaccurately use the IP address and geographical location of the proxy server for both users, when in fact they have different internal IP addresses and very different locations. In contrast, claim 1 of the Application is directed towards a method for determining the actual location of the *user*. Thus, the Applicant respectfully asserts that Dutta fails to disclose using the actual *geographical location of an internet user* connected through a proxy server, as in claim 1 of the Application.

As a third point of rejection with regard to claim 1 of the Application, the Examiner asserts that Dutta discloses:

receiving by the external server the geographic location from the *server within the private network*; and
using the *geographic location of the Internet user* in handling the request for information from the Internet user ([0011]; [0015-0016]) (Emphasis added).

The Applicant respectfully asserts that Dutta, as discussed above, does not disclose an *internal server within a private network* as in claim 1 of the Application, nor does Dutta disclose the geographic location of a *user* connecting to a web server through a proxy server, as in claim 1 of the Application.

With regard to claim 1 of the Application, the Examiner asserts that it would have been obvious to combine Dutta and Eldreth to arrive at the invention of claim 1. Office Action, page 4. The Applicant respectfully asserts that the Examiner has not provided an objective suggestion or motivation to combine Dutta and Eldreth to arrive at claim 1 of the Application.

To prove obviousness, there must be a clear and particular showing to combine the cited references prior art references, based on *actual evidence*. See In re Rouffet, 149 F.3d 1350, 1359 (Fed. Cir. 1998). Further, the fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999).

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The Applicant respectfully asserts that the Office Action provides no objective motivation to combine Dutta with Eldreth for at least the reason that Dutta teaches away from claim 1 of the Application. Dutta discloses a system for determining the legal jurisdiction of an internet user by using the IP address and geographical location of the *proxy server* through which the user connects to the internet:

In the overwhelming majority of situations, Web clients connect to Web servers via proxy servers located within their own jurisdiction. It is rare for a person in United Kingdom to dial-up an America Online service provider in USA and connect to the Internet. Hence in the vast majority of situations, using the jurisdiction of the proxy instead of the actual client *would cause no difference to the result*. Hence, for the remainder of the application, *reference to the network address or IP address of the client shall refer to the address of the client or the proxy of the client*, i.e., a computer acting on behalf of a client. (Dutta at [0031]) (Emphasis added).

Indeed, based upon the size of a legal jurisdiction, Dutta needs no means for, and *expressly disavows*, distinguishing between the geographic location of a user and the proxy server through which they connect. Thus, the Applicant asserts that the Office Action provides no motivation to combine Dutta and Eldreth where Dutta teaches away from claim 1 of the Application by disavowing the need for determining if a user's request is through a proxy server, as well as the need for determining the IP address and location of a *user* connecting through a proxy server.

In view of the above Remarks, the Applicant respectfully asserts that claim 1 is allowable over Dutta and Eldreth for at least the reason that the Office Action fails to establish a *prima facie* case of obviousness where Dutta and Eldreth fail to disclose every limitation of claim 1, and where no motivation to combine the references has been shown.

Independent Claims 3 and 10

The Examiner rejects independent claims 3 and 10 as obvious over Dutta in view of Eldreth, applying the same reasons that were provided for claim 1. See Office Action, pages 4-5. The Applicant respectfully asserts that claims 3 and 10 are allowable for at least the reasons given for claim 1.

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Dependent Claims 2, 4, 5, 6, 7, 11, and 12

The Applicant respectfully asserts that claim 2, which depends from independent claim 1, claims 4, 5, 6, and 7, which depend from independent claim 3, and claims 11 and 12, which depend from independent claim 10, are allowable for at least the reason that each depends from an allowable independent claim.

Rejections Under 35 U.S.C. § 102(e)

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. See In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1994). For anticipation, there must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention. See Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 (Fed. Cir. 1991).

Independent Claim 8

The Examiner rejects independent claim 8 as anticipated by Eldreth. See Office Action, page 2. The Applicant respectfully asserts that Eldreth does not disclose every limitation of claim 8, where claim 8, as currently amended, requires the external server to *redirect* the request for information to an *internal server*.

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Claim 8, as currently amended, states in relevant part:

redirecting, by an external server, a request for the geographic location of the Internet user to an internal server of the private network, wherein the Internet user connects to the external server through the *proxy server*; (Emphasis added).

The Applicant respectfully asserts that Eldreth does not disclose the *redirecting* limitation or the *proxy server* limitation of claim 8 of the Application. Thus, claim 8 of the Application is allowable as not anticipated by Eldreth.

The Applicant also respectfully asserts, for the purposes of argument only, that claim 8, as currently amended, would be allowable as unanticipated by Dutta, or unobvious over a combination of Dutta and Eldreth, for at least the reasoning provided for claim 1 of the Application, and specifically with regard to the remarks provided for the *redirecting* limitation of claim 1.

Dependent Claim 9

The Applicant respectfully asserts that claim 9 is allowable for at least the reason that it depends from allowable independent claim 8.

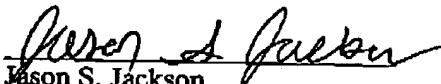
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CONCLUSION

In view of the above, each of the presently pending claims in the application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass the application to issue. If the Examiner believes discussion of any issue would expedite examination, the Examiner is encouraged to telephone the Applicant's undersigned representative. No additional fee is believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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